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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,015	07/06/2006	Klaus Vogelsang	WW045USU	5167

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EXAMINER

LEUNG, KA CHUN A

ART UNIT	PAPER NUMBER
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3747

MAIL DATE	DELIVERY MODE
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03/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/565,015	Applicant(s) VOGELSANG, KLAUS	
	Examiner Ka Chun Leung	Art Unit 3747	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to Applicant's amendments filed on 01/22/2008.

Information Disclosure Statement

2. The International Search Report from PCT/EP2004/007546 and German Search Report from German Application No. 10332907.2-16 listed in the information disclosure filed on 01/18/2006 have been considered and Form PTO-1449 has been updated to include initials next to all cited references.

Drawings

3. The replacement sheets for the drawings were received on 01/22/2008 have been accepted.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 11-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

6. Specifically, base Claim 11 recites the “central ring corresponding to a part of a working chamber of the retarder that is arranged in a flow direction of the coolant downstream of a coolant carry retarder inlet region” and further “wherein the coolant outlet of the coolant pump to the central ring of the retarder has a first flow resistance that is measured when the retarder is connected...” (emphasis added). The specification does not disclose actually measuring the flow resistance nor does the specification or drawings provide a sensor or other device for performing such a measurement. Instead, Page 5 of the specification cites “[i]n the braking mode of the retarder, the flow resistance between the pump outlet 1.1 and a position in the central ring of the retarder 2 is laid out in such a way that it lies below the previously described total flow resistance of the coolant circuit in the non-braking mode.” Similarly, original Claim 1.6 recites “when the retarder is connected, the total flow resistance from the outlet (1.1) of the coolant pump (1) to the central ring (2.1) of the retarder (2) is lower than the total flow resistance of the coolant circuit to be overcome by the coolant pump (1) in the non-braking mode”. While support is provided for the first flow resistance (braking mode) to be lower than that of the second flow resistance (non-braking mode), there is no support for the flow resistance being measured.

Response to Remarks/Arguments

7. Applicant's arguments, see Page 8, filed 01/22/2008, with respect to Claims 11, 13, 14, 18 and 27 have been fully considered and are persuasive. The rejection of Claims 11, 13, 14, 18 and 27 under 35 USC § 112, second paragraph have been

withdrawn. The amendment to the specification in paragraph [0029] now provides clarity as to the function performed by the reversing valve.

8. Applicant's arguments with respect to Claims 11-26 have been considered but are moot in view of the new ground(s) of rejection. The specification is non-enabling with respect to the limitation of having a first flow resistance between the coolant pump outlet and the central ring "that is measured". With regards to Applicant's remarks on Page 10-11 that "[m]erely providing that the retarder when driven also acts as a pump fails to disclose or suggest that the coolant outlet of the coolant pump to the central ring of the retarder has a first flow resistance that is measured when the retarder is connected to the coolant circuit is lower than a second flow resistance to be overcome by the coolant pump when the retarder is disconnected from the coolant circuit", the flow resistance at coolant pump outlet of Edelmann in view of either Nagel or Campbell et al would inherently be lower while the retarder is connected since the retarder would perform a pumping function and therefore be pulling coolant downstream of the coolant pump and therefore reduce the flow resistance as opposed to when the retarder is bypassed and not connected to the cooling circuit. This is not unlike the arrangement of the present disclosed invention where the coolant pump is arranged upstream of the retarder and a switch over/reversing valve is disposed between to allow the coolant to be directed to the retarder or bypassed. It is noted however that the references of Edelmann, Nagel and Campbell et al do not disclose the flow resistance of the coolant to be overcome by the coolant pump being measured.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

10. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ka Chun Leung whose telephone number is (571)272-9963. The examiner can normally be reached on 7:30AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Cronin can be reached on (571) 272-4536. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3747

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ka Chun Leung/
Examiner, Art Unit 3747

/Stephen K. Cronin/
Supervisory Patent Examiner, Art Unit 3747